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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/844,354	04/27/2001	Tomoko Terakado	450100-4138.1	3992
20999 7590 03/18/2009 FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL.. NEW YORK, NY 10151				
EXAMINER				
BROWN, RUEBEN M				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/844,354

Applicant(s)

TERAKADO ET AL.

Examiner

REUBEN M. BROWN

Art Unit

2424

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☒ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. 08/946524.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 12/29/08 have been fully considered but they are not persuasive. Applicant argues on page 18 that the combination of references do not teach the newly amended feature, 'wherein an updated EPG is displayed by combining the first information received from a first delivery medium and the second information from the second deliver medium'.

Examiner respectfully disagrees. Tarr provides a teaching of regular EPG data regarding scheduled transmissions of programs being conventionally broadcast and/or transmitted by cable modem, col. 4, lines 16-19; col. 5, lines 5-25. The reference goes on to disclose a clear teaching that enhancement data for the EPG may advantageously be provided on a CD-ROM. Tarr teaches that a variety of data that will enhance the EPG display could be found on the CD-ROM 38, such as graphics, animations, video clips, etc., see col. 5, lines 35-67. Thus, in Tarr first & second information, being delivered on a first & second delivery medium, are combined for display on the EPG interface, see col. 6, lines 29-40; Fig. 2 & Fig. 3.

It is pointed out that even though Tarr generally discusses that the content of the broadcast programs would be video games, instead of regular TV programs, as in Roop &

Lawler, the references are still combinable. Tarr is compatible with Roop & Lawler, particularly since Fig. 3 of Tarr discloses an EPG display that shows a schedule of program broadcast(s) that would correspond with the EPG schedule of broadcasts from Roop & Lawler. The difference in content being broadcast is a peripheral issue, since the technology is compatible, i.e., informing subscribers of date & time of program broadcast.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 11, 21 & 24 are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention.

Considering claims 11, 21 & 24, while the claims recite a series of steps or acts to be performed, a statutory “process” under 35 U.S.C. 101 must (1) be tied to particular machine, or (2) transform underlying subject matter (such as an article or material) to a different state or thing. See page 10 of *In Re Bilski* 88 USPQ2d 1385. The instant claims are neither positively tied to a particular machine that accomplishes the claimed method steps nor transform underlying subject matter, and therefore do not qualify as a statutory process. The information

providing method including steps of ... 'hierarchizing...'; 'providing at least one of the first information & second information...'; 'providing layout information...'; 'combining...'; and 'displaying...' is broad enough that the claim could be completely performed mentally, verbally or without a machine nor is any transformation apparent.

For example, 'hierarchizing EPG information...first information...second information' can be performed by a first person looking at a printout of TV listings data, and using a pencil and paper, sorting two types information regarding TV program listings, such that the two types of information are related. 'providing layout information...which relates to a layout of the EPG' reads on the printout including information with respect to a layout of the EPG.

'combining...' reads on the first person receiving the first information on the piece of paper and the second information by visually observing EPG data on a screen and then combining the two informations on the piece of paper.

'displaying the EPG according to a delivery medium' reads on displaying the information from the paper in one manner, and the observed information in a different manner, at least since they are not received in the same format.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lawler, (5,585,838), view of Roop, (U.S. Pat # 5,790,198) and Tarr, (U.S. Pat # 5,935,004).

Considering claims 1, 11-12, the claimed information providing apparatus and method, comprising;

'hierarchizing section for hierarchizing EPG information to be provided into first information which designates predetermined information on specific broadcast programs, and second information, referred to by the first information as general information on the program', is met by the disclosure of Lawler, (Fig. 4A-4C; col. 11, lines 10-65). Lawler teaches that the EPG display provides a plurality of channel slots/objects that contain the titles of broadcast programs. Both the channel slots and the focus frame 102 that highlights a selected channel slot reads on the claimed first information. The second information reads on the title of the programs

in Lawler. The '*hierarchizing means*' reads on the headend 12 in Lawler, which generates EPG data, see Fig. 1; col. 6; col. 12, lines 60-67 thru col. 13, lines 1-10.

Lawler does not specifically discuss whether one of the EPG information may or may be changed. However, the additional feature of, '*wherein the first information, which can be changed, comprises EPG information associated with a program*', reads on the broadcast start time of a particular broadcast program, see Roop, col. 75, lines 30-67 thru col. 76, lines 1-25; col. 77, lines 15-35; col. 81, lines 10-48& Table LXI. It would have been obvious for one of ordinary skill in the art at the time the invention was made, to modify Lawler with the feature of updating changed broadcast time of programs, providing the subscriber with update schedule information as taught by Roop.

'and the second information, which cannot be changed, comprises EPG information associated with a program', is broad enough to read on any of the parameters of the Show list record that are not changed, and any parameters of the EPG in Lawler that are not changed.

'first providing section for providing at least one of the first information and second information', is inherent in Roop which discloses the EPG information packets, that carry EPG data from a broadcaster to a subscriber terminal, see Table LXI.

'second providing section for providing layout information which relates to a layout of the EPG information when displayed on the screen, wherein the first information and the second

information each include a tag to enable the data included therein to be associated with the layout information', is inherent in both Lawler & Roop, since the elements of the EPG records are synchronized for display as a unit.

The claimed '*layout information*' reads on the combination of Lawler (col. 7, lines 51-65 & col. 8, lines 21-45) and Roop.

As for the additionally claimed feature of, '*wherein the EPG is displayed according to a delivery medium*', Lawler & Roop do not discuss displaying the images with respect to any particular delivery medium. Nevertheless, Tarr provides a teaching of displaying images according to whether the EPG data was conventionally broadcast or received via a CD-ROM. In particular, Tarr teaches that the headend server transmits EPG data for receipt by the primary processor of the subscriber terminal, col. 4, lines 16-20. Tarr further goes on to teach that secondary processor of the subscriber terminal receives a CD-ROM 38 that includes graphics, animation, video clips, etc., col. 5, lines 41-55. Therefore, Tarr displays the regular EPG broadcast schedule information, as shown in Fig. 3, which represents data delivered to subscriber terminal via a broadcast. Likewise, Tarr displays the graphics, animation, video clips, artwork etc. related to the EPG, delivered via a CD-ROM, and thus meets the claimed subject matter.

It would have been obvious for one of ordinary skill in the art at the time the invention was made, to modify the combination of Lawler & Roop, with the technique of providing enhancement information for display with an EPG via a CD-ROM, at least for the advantage of

providing images that require high megabytes via the instant CD-ROM 38, which conserves bandwidth for transmission of other material, as taught by Tarr, col. 1, lines 37-67.

Regarding the further claimed 'wherein an updated EPG is displayed by combining the first information received from a first delivery medium and the second information from the second deliver medium', Tarr teaches that data used for EPG display is transmitted and received by the primary processor, col. 5, lines 5-25; col. 6, lines 48-66. The CD-ROM 38 of Tarr includes multimedia content (graphics, animations, video clips, etc.) which can be used with the data that is broadcast over the network, emphasis added. Therefore the combination of references meets the limitation of the updated EPG being displayed by combining the first & second information received from first & second delivery medium.

Regarding the claimed '*computer program stored on a computer readable medium*' as recited in claim 12, Lawler (Fig. 2; col. 7 & col. 8), Roop (Fig. 5; col. 13) & Tarr (col. 5, lines 5-41) all teach operating the system on a computerized subscriber terminal.

Considering claims 2, 6 & 20, Lawler teaches that EPG may be transmitted to the station controller 18, at least by satellite or CATV which meets the requirement, see col. 7, lines 1-15. Furthermore, Tarr discloses transmitting first information via a regular broadcast and delivering the second information by a CD-ROM, which also meets claimed subject matter.

Considering claim 3, Roop teaches that the EPG may be updated, col. 77, lines 20-35.

Considering claims 4-5, Roop teaches the use of the VBI to transmit the EPG data, col. 56, lines 5-15; col. 60, lines 40-64.

Considering claims 7-8, Roop teaches detecting when information within the EPG needs to be updated and only updating that information, which reads on the claimed subject matter, col. 75, lines 30-55; col. 76, lines 10-22.

Considering claims 9-10, the claimed third & fourth information reads on the additional information associated with the programs in Roop, see Table LXI. As for the information identifying a performer, Roop teaches that one of the parameters associated with a TV program may be the actor(s) such as Star 1- Star 3, col. 78, lines 35-45.

Considering claims 13, 15-16 & 21-25, the claimed elements that correspond with subject matter mentioned above in the rejection of claims 1 & 11, are likewise treated. The additionally claimed features of a first and second acquiring section for acquiring information regarding the first and second information and the layout information is met by the operation of the interactive station controller 18, Lawler col. 7, lines 20-25 & col. 8, lines 21-30, which controls storing and retrieving the EPG information from storage. The claimed *'producing section for producing display information'*, reads on the operation of the graphics subsystem 62, which includes video processor subsystem 63 and mixer 64, see col. 7, lines 50-60, in Lawler, in combination with Tarr.

Considering claim 14, Lawler provides a display means (Fig. 2).

Considering claims 17-18, the feature of first information means designated as second intermediate information reads on combination of Lawler, such as the program grid 80 and program tile 88, col. 8, lines 45-60 & Fig. 3 and Roop.

Considering claim 19, Lawler teaches that the layout information may be received over a wired or satellite connection, and at least temporarily stored in memory in the station controller 18, col. 5, lines 45-60 & col. 7, lines 44-65.

Any response to this action should be mailed to:

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or faxed to:

(571) 273-8300, (for formal communications intended for entry)

Or:

(571) 273-7290 (for informal or draft communications, please label
"PROPOSED" or "DRAFT")

Any inquiry concerning this communication or earlier communications from the examiner should be directed to REUBEN M. BROWN whose telephone number is (571) 272-7290. The examiner can normally be reached on M-F(8:30-6:00), First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Kelley can be reached on (571) 272-7331. The fax phone numbers for the organization where this application or proceeding is assigned is (571) 273-8300 for regular communications and After Final communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Reuben M. Brown/

Examiner, Art Unit 2424